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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,564	05/26/2000	Bradford C. Van Wagenen	072827-1002	1913

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EXAMINER

JONES, DWAYNE C

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,564

Applicant(s)

VAN WAGENEN ET AL.

Examiner

Dwayne C. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the amendment of 01MAR2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 77-85,87 and 88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 77-85,87 and 88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/14/6/1/4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: IDS of 8/23/4.

DETAILED ACTION

Status of Claims

1. Claims 77-85 and 86-88 are pending.
2. Claims 77-85 and 86-88 are rejected.
3. Claim 86 was cancelled as per the amendment of March 1, 2004.

Response to Arguments

4. Applicant's arguments filed March 1, 2004 have been fully considered but they are not persuasive. Applicant alleges that the claims are free of the prior art of record as currently amended with the incorporation of the second conditional phrase for the term "Alkyl" regarding the presence of a be both a C₃ to C₆ hydrocarbon which has sp² and/or sp³ hybridization and must be a cycloaliphatic ring. However, the prior art reference of Walker et al. clearly teach of species which fall under this new definition for the instant term of "Alkyl". In addition, the obviousness type double patenting rejections are still applicable over U.S. Patent No. 6,001,884 and U.S. Patent No. 6,011,068 because one having ordinary skill in the art would have been motivated to select alkyl containing moieties in the compound in these closely related structures and because both the instantly claimed subject matter as well as U.S. Patent No. 6,001,884 and U.S. Patent No. 6,011,068 teach of broad definitions of variables, which clearly overlap one another.

Information Disclosure Statement

5. The information disclosure statements filed on March 1, 2004; June 1, 2004; and August 23, 2004 have been reviewed and considered, see enclosed copies of PTO FORMS 1449.

Claim Objections

6. Claim 77 is objected to because of the following informalities: the variable of "alkyl" should be capitalized in order to more accurately correspond with the "Alkyl" moiety in the formula. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 81 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There are currently two formulas present in the claim as currently written and one has cancelled variables of Ar^1 and Ar^2 . It appears the original formula was not properly cancelled via strikethrough and the newly submitted formula was not underlined. These anomalies render the claim vague and indefinite.

9. Claim 85 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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10. Claim 85 recites the limitation "methinylcyclopropy moiety" in the last listed Compound in claim 85. There is insufficient antecedent basis for this limitation in the claim. This is because the new limitation in independent claim 77 for the variable of Alkyl requires that an alkyl moiety must be both a C₃ to C₆ hydrocarbon which has sp² and/or sp³ hybridization and must be a cycloaliphatic ring.

11. Claim 88 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 88 as currently written has dependency on "any one of Claims 77-87"; however, claim 86 is presently cancelled, thus rendering claim 88 vague and indefinite because it now dependent on cancelled claim 86.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. The rejection of claims 77-85 and 87-88 under 35 U.S.C. 103(a) as being unpatentable over Wallker et al. is maintained and repeated. The prior art reference of Walker et al. teach of the compounds of general formulas (III) and (IV), (see pages 624-627). These compounds of Walker et al. are embraced by the generic definitions that are instantly claimed by applicants. In fact, Walker et al. teach of Compound Nos. 98, 102, and 105, which contain cyclohexyl ring moieties. Accordingly, the skilled artisan would have been motivated to select any of the species of the genus taught by the

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reference because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties as the genus as a whole.

Obviousness-type Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. The rejection of claims 77-85 and 87-88 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S.

Patent No. 6,001,884 is maintained. Although the conflicting claims are not identical, they are not patentably distinct from each other because of breadth of the claims of both the instant application as well as U.S. Patent No. 6,001,884 one having ordinary skill in the art would have been motivated to select alkyl containing moieties in the compound in these closely related structures.

16. The rejection of claims 77-85 and 87-88 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S.

Patent No. 6,011,068 is maintained. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because of breadth of the claims of both the instant application as well as U.S. Patent No. 6,011,068 one having ordinary skill in the art would have been motivated to select alkyl containing moieties in the compound in these closely related structures.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-

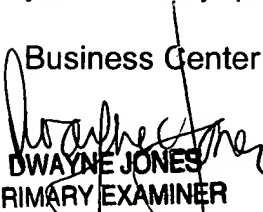
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0578. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, and Fridays from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, may be reached at (571) 272-0951. The official fax No. for correspondence is (571)-273-8300.

Also, please note that U.S. patents and U.S. patent application publications are no longer supplied with Office actions. Accordingly, the cited U.S. patents and patent application publications are available for download via the Office's PAIR, see <http://pair-direct.uspto.gov>. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll free).


DWAYNE JONES
PRIMARY EXAMINER

Tech. Ctr. 1614

May 2, 2005